

Application No. 10/693,163

January 14, 2005

Amendment responsive to Office Action of October 14, 2004

Remarks

All pending Claims 1 – 20 stand rejected by the Examiner under 35 U.S.C. §102(e). The reference relied upon by Examiner to reject the claims is U.S. 6,804,684 B2 issued to *Stubler et al.* Claim 17 stands rejected under 35 U.S.C. §112.

In response to the Office action, Applicant has amended claims 1, 10, and 18. Claims 2-9, 11-17, 19, and 20 depend on the amended claims and are thereby also amended. Claim 17 is amended to address the rejection under 35 U.S.C. §112. Claims 1-20 now remain pending and are presented for further examination.

Requirements for *Prima Facie* Anticipation

A general definition of *prima facie* unpatentability is provided at 37 C.F.R. §1.56(b)(2)(ii):

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (emphasis added)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundscriber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, *Stubler et al* must disclose each element recited therein. "There must be no difference between the claimed

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invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i. e.*, show that *Stubler et al* fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

Application of Anticipation Requirements

With respect to the rejection of independent claims 1, 10, and 18, the Examiner cites Figs. 5-7 of the *Stubler et al* reference for its teaching of searching a database for similar images, collecting metatags, and gathering statistics.

Applicant teaches a database statistics module that is an enhancement to a standard content-based image retrieval module. Database statistics are stored in the database statistics module so that the time consuming task of gathering the statistics is replaced by a simple query into the database statistics module. Furthermore, adding an image to the image database does not automatically cause the database statistics module to be updated. Rather, a separate step is required to update the database statistics module. Applicant has amended independent claims 1, 10, and 18 to account for this point of novelty.

Claim 1 provides the following language:

automatically offering a user a set of keywords associated with stored images that most closely match the new image that is based on image comparison results derived from said step of comparing, wherein said offering is based on the time of entry for similar images and the

number of occurrences of the similar images when compared to the new image that have been historically processed by the database as indicated by database statistics provided by a database statistics module.

Claim 10 provides the following language:

(b) automatically offering a user a set of keywords associated with stored images that most closely match the new image that is based on database statistics provided by a database statistics module and on image comparison as provided in step (a).

Claim 18 provides the following language:

a database statistics module for providing statistical data regarding the number and type of images and metadata stored in the database wherein the database statistics module is updated whenever an image is added to or removed from the database such that the database statistics module remains current.

Stubler et al does not teach a database statistics module, but does teach that statistics can be gathered from the information in a database.

Stubler et al does not teach a content-based image retrieval module that is enhanced by a database statistics module. *Stubler et al* does teach a content-based image retrieval module that pulls images from a database and that the database also holds metatags that are associated with the images.

The foregoing reasons, rejection of claims 1, 10 and 18 as amended is respectfully traversed and examiner is requested to reconsider all the pending claims.

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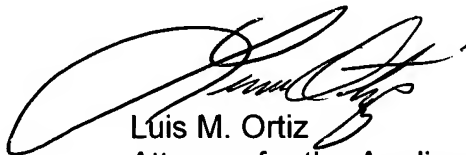
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Conclusion

In view of the foregoing remarks, the Applicant submits that Claims 1-20 are patentably distinct over the references and are in allowable form. Accordingly, the Applicant earnestly solicit the favorable consideration of their application, and respectfully request that it be passed to issue in its present condition.

Should the Examiner discern any remaining impediment to the prompt allowance of the aforementioned claims that might be resolved or overcome with the aid a telephone conference, he is cordially invited to call the undersigned at the telephone number set out below.

Respectfully submitted,



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